

### **REMARKS**

Claims 24, 25, 27-32, 35 and 37-74 remain pending after amendment, with claims 57-68 being withdrawn from consideration.

#### **Specification Amendments**

The specification is amended to insert the respective headings required by the Examiner. No new matter is added by this amendment.

#### **Claim Amendments**

By this amendment, editorial amendments are made in claims 45, 46, 47, 48, 49, 50, 51, 52, 53, 54, 55 and 56. New claims 69-74 are also added where the use of tomato juice or tomato passatas are separately recited, support for which resides in the independent claims from which the new claims depend. New claims 73 and 74 are added directed to embodiments of claim 35. No new matter is added by this amendment.

#### **Election/Restriction Requirement**

Applicant acknowledges the withdrawal of claims 57-68 from consideration.

#### **Withdrawal of Rejection under 35 USC 102(b)**

Applicant acknowledges with appreciation the withdrawal of the rejection under 35 USC 102(b) over Glasser et al.

**Rejection under 35 USC 112 (paragraph one)**

Claims 25, 27-32, 35, 40, 42, 44 and 56 stand rejected under 35 USC 112 (paragraph one) as failing to comply with the written description requirement. This rejection is respectfully traversed.

In support of the rejection, the Examiner takes the position that applicant does not have support for the claimed ranges of claims 25 and 56 of 20-30% water insoluble components and 70-80% water soluble components.

In response, applicant submits that the referenced ranges find support at page 4, lines 1-13 of the specification. That is, page 4 of the specification states that the water insoluble solids may be present in an amount of from 20-50% by weight, with a preferred range of from 30-50% by weight. Page 4 also states that the water soluble solids may be present in an amount of from 80-50% by weight, with a preferred range of from 70-50% by weight.

The above collective disclosure clearly provides basis for the ranges recited in claims 25 and 56.

The rejection should accordingly be withdrawn.

**Rejection under 35 USC 112 (paragraph two)**

Claims 45-56 stand rejected under 35 USC 112 (paragraph two) as not distinctly claiming the invention. This rejection is respectfully traversed.

In response, the rejected claims are amended in a manner which is believed to overcome the rejection. The rejection is thus believed to be moot, and should be withdrawn.

**Rejections under 35 USC 103(a)**

The Examiner issues the following prior art rejections against the pending claims:

(1) Claims 24, 25, 27-30, and 37-44 stand rejected under 35 USC 103(a) as being unpatentable over **Glasser '809** in view of **Tanglepaibul**

(2) Dependent claim 31 stands rejected under 35 USC 103(a) as being unpatentable over **Glasser** in view of the **Benefits** reference.

(3) Dependent claims 32, 35 and 36 (canceled) stand rejected under 35 USC 103(a) as being unpatentable over **Glasser** in view of **Terrytx**.

(4) Claims 24, 25 and 45-56 stand rejected under 35 USC 103(a) as being unpatentable over **Bueno**.

These rejections are respectfully traversed.

***Applicable Legal Standard***

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

“There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998).

“In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification.” *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The Supreme Court of the United States has recently held that the teaching, suggestion, motivation test is a valid test for obviousness, but one which cannot be too rigidly applied. See *KSR Int’l Co. v Teleflex Inc.*, No. 04-1350, slip op. at 11 (U.S. April 30, 2007).

The Supreme Court in *KSR Int'l Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. April 30, 2007) reaffirmed the Graham factors in the determination of obviousness under 35 U.S.C. § 103(a).

The four factual inquiries under Graham are:

- (a) determining the scope and contents of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating evidence of secondary consideration.

*Graham v. John Deere*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

The Court in *KSR Int'l Co. v. Teleflex, Inc.*, *supra.*, did not totally reject the use of "teaching, suggestion, or motivation" as a factor in the obviousness analysis. Rather, the Court recognized that a showing of "teaching, suggestion, or motivation" to combine the prior art to meet the claimed subject matter could provide a helpful insight in determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a).

Even so, the Court in *KSR Int'l Co. v. Teleflex, Inc.*, *ibid.*, rejected a rigid application of the "teaching, suggestion, or motivation" (TSM) test, which required a showing of some teaching, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the prior art elements in the manner claimed in the application or patent before holding the claimed subject matter to be obvious.

Applicant submits that the Examiner fails to present a *prima facie* case of obviousness in relation to the cited prior art.

***Rejection over Glaser and Tanglepaibul***

In support of rejection (1) based in part on **Glaser**, the Examiner takes the position that **Glaser** teaches (1) “that one would modify the amount of soluble and insoluble solids depending on the desired freezing properties of the soup concentrate”, (2) “the vegetable composition in admixture with animal and vegetable fats which are solid or liquid at room temperature”, and (3) that “the meat and/or solid preservatives, such as salt can be added (i.e., sauced by) the tomato composition”.

The Examiner admits, however, that **Glaser** “does not explicitly teach the composition as including 18-30% water insoluble solids and 80-94.5% or 70-80% water insoluble solids, based on the total solids content as recited in claims 24 and 25, to the soup concentrate or soup composition as a ready to use sauce for food as recited in claims 39 and 40 or a food comprising the tomato composition as recited in claims 43 and 44.”

The Examiner further acknowledges that **Glaser** teaches “the tomato composition contains about 33-68% soluble solids based on the dry residue in the final composition, and about 32-67% insoluble solids based on the dry residue in the final composition.” As such weight percentages differ significantly from those of the claimed invention (i.e. 18-30% or 20-30% water insoluble solids, and 80-94.5% or 70-80% water soluble solids), the Examiner relies on **Tanglertpaibul** to teach “that it was known to decrease the amount of water-insoluble solids in a tomato composition in order to decrease the viscosity and vice versa (Abstract).”

The Examiner accordingly concludes that it would have been obvious to increase the water insoluble solids content to increase the viscosity of the product, stating to “increase a known ingredient for a known intended result does not provide a patentable distinction to the claims absent any clear and/or convincing evidence and/or arguments to the contrary.”

The Examiner's position is without basis.

Applicant initially notes that the Examiner primarily focuses on the soluble/insoluble solids content of the composition of **Glasser**, while also stating at page 6 of the Action with respect to the identity of the **Glasser** composition that:

“**Glasser** teaches of a soup concentrate derived from vegetable matter, including tomatoes (i.e., **Glasser** teaches of a tomato composition). **Glasser** teaches that the tomato composition is obtained from tomato juice. Refer specifically to Abstract and Example 2.”

The referenced Abstract contains no reference to tomatoes, merely vegetables (“A variety of soup concentrates, each containing meat or vegetable particulates . . .”). Indeed, **Glasser** defines exemplary vegetables at column 3, lines 55-62 as follows:

“Such cooked vegetable and meat pieces as mushroom slices, chicken pieces, beef pieces, corn peas, etc. are incorporated in judicious quantities into the mixture. Generally, these ingredients make up about 3.0 to about 30 percent by weight of the total weight of the concentrate. The variation in weight of the particles depends primarily on the type or variety of concentrate being formulated.”

Again, no mention is made of the presence of tomatoes with reference to the cooked vegetable embodiment.

Reference to tomatoes does reside at Example II as noted by the Examiner. However, such reference is in relation to a “cooked vegetable paste” component, which component is stated to comprise a “blend of 28.3% tomato paste (30% solids), 34.7% pea paste (18.5% solids) and 37.0% carrot paste (8.8% solids) cooked and pureed.”

Of the total vegetable soup concentrate of Example II of **Glasser**, the cooked vegetable paste comprises 12.8% by weight. As the tomato paste component only comprises 28.3% of the vegetable paste, the overall tomato-based content of the vegetable soup concentrate is *only 3.6% by weight*. It is accordingly quite a stretch of the facts to characterize **Glasser's** vegetable soup

concentrate as a “tomato composition obtained from tomato juice or tomato passatas” consistent with the claimed invention. Indeed, given such a distinction, the relevance of the **Glasser** disclosure to the claimed invention is suspect at best. One of ordinary skill in the art, in seeking to provide a tomato-based composition in accordance with applicant’s invention, clearly would not receive any guidance from the **Glasser** reference which is directed to a substantially non-tomato-based soup concentrate.

Despite the noted non-relevance of **Glasser** to the claimed invention, the Examiner relies on **Tanglertpaibul** to “teach that it was known to decrease the amount of water-insoluble solids in a tomato composition in order to decrease the viscosity and vice versa (Abstract)”, concluding that “It would have been obvious to one of ordinary skill in the art at the time the invention was made to increase the amount of water insoluble solids in the tomato composition as taught by **Glasser** in order to increase the viscosity of the final product.”

Assuming for the sake of argument that the Examiner’s reliance on **Tanglertpaibul** is correct, the net result still does not yield the claimed invention, particularly in view of the deficiencies of **Glasser**. Indeed, even if the amount of water-insoluble solids is achieved by increasing the viscosity of the soup concentrate of **Glasser**, such ignores the other limitations of dry residue being present in an amount of from 5.5-20% by weight, and water being present in an amount of 94.5-80% by weight. Further, the amount of water-insoluble solids present is based on the dry residue component, not the overall composition. Such results are not achieved merely by reducing the viscosity of the composition. The position of the Examiner is based on an improper hindsight analysis of the cited prior art.

Even assuming that **Glasser** is relevant to the issue at hand, a detailed review of the teachings of the reference confirms its failure to teach or suggest the claimed invention.



More specifically, **Glasser** is directed to a soup concentrate defined as constituted of soup ingredients which are water soluble and those which are water insoluble, combined with a limited amount of water:

"The essence of the invention resides in the discovery that conventional soup ingredients which are water soluble and those which are water insoluble when, combined with a limited amount of water in correct proportions , will cooperate to... "(column 3, lines 8-12)

The composition of soup concentrates is defined at lines 13-22 of column 4 of **Glasser**:

"However, it is essential that each soup concentrate of this invention be formulated with water solutes and water insoluble solids to the extent that the ratio of solute to insoluble solids ranges from about 2:1 to about 0.25: 1. The soup concentrates , in order to fall within the province of the invention, have a total moisture content ranging from about 40% to about 60%; water solutes ranging from about 20% to about 40%; and water insoluble materials ranging from about 10% to about 40%; based on the weight of concentrate. "

Applicant uses the values stated at lines 13 –22 above in order to provide several calculations directed to the content of water soluble and water insoluble components present in the disclosed composition. Both calculations have the same final purpose – to compare the **Glasser** patent with the present application. This comparison addresses the content of water soluble solids (water solutes) and water insoluble solids found in 100 grams of dry residue of soup concentrates.

Starting with the disclosure at lines 13-17, column 4 of **Glasser**:

"However it is essential that each soup concentrate of this invention be formulated with water solutes and water insoluble solids to the extent that the ratio of solute to insoluble solids ranges from about 2:1 to about 0.25:1 "

the content of water solutes and water insoluble solids in 100 g of dry residue of soup concentrate is calculated.

The ratio 2:1 (soluble solids: insoluble solids) quoted by **Glasser** is then examined. This ratio means that out of 3 parts of totals solids, 2 parts are soluble solids and 1 part is insoluble solids. Therefore, in 100 g of total solids  $2/3$  of the total will be soluble solids and  $1/3$  insoluble solids as follows: soluble solids  $(2/3 \times 100) = 66.67\%$  and insoluble solids  $(1/3 \times 100) = 33.33\%$ .

Taking the second value quoted by **Glasser** of 0.25:1, and making the same calculation, the following results are obtained: Soluble solids  $(0.25/1.25) \times 100 = 20\%$  and insoluble solids  $(1/1.25) \times 100 = 80\%$ .

In conclusion, the sentence at column 4, lines 13-17 of **Glasser** can be rewritten as follows without altering the meaning:

“However, it is essential that each soup concentrate of this invention be formulated with water solutes and water insoluble solids to the extent that the percentage in the dry residue ranges in percentage by weight as follows: water soluble solids in an amount of from 66.67% to 20% and water insoluble solids in an amount of from 33.33% to 80%”.

With reference to lines 17-20, column 4 of the patent:

"The soup concentrates, in order to fall within the province of the invention, have a total moisture content ranging from about 40% to about 60% , water solutes ranging from about 20% to about 40%"

the water solutes (water soluble solids) and water insoluble solids contained in 100 g of dry residue are calculated.

As indicated by the Examiner, in order to calculate the water insoluble solids contained in 100g of dry residues, the amount of water solutes (water soluble solids) in 100 g of dry residue are deducted.

Correspondingly, if water solutes in a concentrate range in percentage by weight range from 20% to 40%, and if the soup concentrate in order to fall within the scope of the invention has a total moisture content ranging from 40% to 60%, the dry residue in 100 g of soup

concentrate therefore ranges from 60% to 40% - there are thus two possibilities based on the maximum and minimum amounts of water solutes (20 and 40%):

- (1) water solutes 20g in 40g dry residue -water solutes 40g in 60g dry residue
- (2) water solutes 40g in 40g dry residue -water solutes 20g in 60g dry residue

Possibility No. 1: water solutes 20g in 40g dry residue and water solutes 40g in 60g dry residue.

In 40 g of dry residue there will be 20 g of water solutes (water soluble solids) and consequently, in 100g of dry residue there will be 50 g of water solutes. Therefore in 100 g of dry residue, the total water insoluble solids will be 50 g ( $100-50=50\%$ ).

In 60g of dry residue there will be 40 g of water solutes (water soluble solids), and consequently, in 100 g of dry residue, the total water solutes will be 66.67 g. Therefore, in 100 g of dry residue, the total water insoluble solids will be 33.33 g ( $100 - 66.67 = 33.33\%$ ).

In conclusion, water soluble solids and water insoluble solids in the dry residue range in percentage by weight as follows: water soluble solids range from 66.67% to 50%, and water insoluble solids range from 33.33% to 50%.

Possibility No. 2: water solutes 40g in 40g dry residue and water solutes 20g in 60g dry residue.

Repeating the calculations executed for the first possibility, in 40 g of dry residue there will be 40 g of water solutes (water soluble solids), and consequently, in 100g of dry residue there will be 100 g of water solutes. Therefore in 100 g of dry residue, the water insoluble solids will be 0 g ( $100-100 = 0\%$ ).

In 60 g of dry residue there will be 20 g of water solutes (water soluble solids), and consequently, in 100 g of dry residue, the total water solutes will be 33.33g. Therefore, in 100 g of dry residue, the water insoluble solids will be 66.67 g ( $100 - 33.33 = 66.67\%$ ).

In conclusion, the total water soluble solids range from 100 to 33.33% and the total water insoluble solids range from 0 to 66.67% in the dry residue range in percentage by weight.

In column 3, lines 8-12, of **Glasser** it is noted:

*" the essence of the invention resides in the discovery that conventional soup ingredients which are water soluble and those which are water insoluble when, combined with a limited amount of water in correct proportions, will cooperate to.... "*

And in column 4, lines 13-17 of **Glasser**, it is stated:

*" However it is essential that each soup concentrate of this invention be formulated with water solutes and water insoluble solids to the extent that the ratio of solute to insoluble solids range from about 2:2 to about 0.25:1 "*

From these sentences it is obvious that **Glasser** describes products that always contain *insoluble* solids.

So, excluding the instance of 100%, the segment of soluble solids considered by **Glasser** is the range 33.33%-67.67%. This segment is outside of the scope of the pending claims (which require the presence of 70-82% soluble solids).

Thus, not only is the **Glasser** patent irrelevant to the issue of patentability of the claimed invention, but the patent is admittedly deficient in its teachings. Even if the patent is deemed relevant to the patentability of a tomato-based composition, which applicant disputes, the patent fails to teach or suggest the requisite compositional limitations (as admitted by the Examiner).

As the additionally-cited reference fails to cure such deficiencies, the combined teachings of the references fails to result in the claimed invention. Rejection (1) above is thus improper and should be withdrawn.

***Rejections over Glasser in view of Benefits or Terrytx***

With regard to rejections (2) and (3) directed to claims 31, 32 and 35 (claim 36 being canceled), applicant has demonstrated that the invention of independent claims 24 and 25 is neither disclosed nor suggested by **Glasser**. As such, the additional citation of secondary references in rejections (2) and (3), which do not cure the deficiencies of **Glasser**, confirm that these additional rejections are similarly improper.

Indeed, applicant has unexpectedly and surprisingly found that the claimed composition can incorporate, for example, by mechanical mixing, without exhibiting serum separation, animal and vegetable fats which are solid at room temperature, such as, for example, butter or margarine, and/or fats liquid at room temperature as, for example, vegetable oils (such as olive oil and/or cheese). For example, applicant's Examples are directed to the use of olive oil (Examples 3 and 4), butter (Examples 5 and 6), soft grain cheese (Example 7) and hard grain grated cheese (Example 8).

This property is especially surprising as it is known that animal and/or vegetable fats which are either solid or liquid at room temperature and/or cheese are not mixable with tomato-based compositions as such, or with common canned tomato products.

The property of incorporating fats and/or cheeses allows one to obtain homogenous compositions (see Examples 3-9 noted above) with organoleptic properties superior to those of similar compositions prepared with common tomato products – i.e., Examples 3 and 4 are directed to the preparation of a tomato composition containing vegetable oil, Examples 5 and 6 are directed to the preparation of a tomato composition containing butter, Examples 7 and 9 are directed to the preparation of a tomato composition containing soft grain cheese, and Example 8 is directed to the preparation of a tomato composition containing hard grain grated cheese.

The invention of claims 31, 32 and 35 is neither disclosed nor suggested by the cited prior art.

The deficiencies of the primary reference are discussed above. More specifically, the Examiner cites two secondary references – i.e., **Benefits** (The Benefits of Olive Oil), and **Terrytx** (Creamy Tomato Cheese Soup), 1999 Recipelink.com.

The first publication only talks about the benefits of olive oil and does not appear to be relevant to the present claims. The second publication teaches how to prepare a soup containing tomato (tomatoes skinned and chopped or canned chopped tomatoes), margarine and low fat cheese. Nothing is said that the margarine and the low fat cheese are *incorporated in* the soup. On the contrary, the publication states "Blend the soup until smooth in a liquidiser or food processor. Return to the saucepan and add the cheese, stirring to melt." It is evident that the cheese melts and remains by itself.

Rejections (2) and (3) are thus without basis and should be withdrawn.

### ***Rejection over Bueno***

In support of rejection (4), the Examiner acknowledges that "**Bueno** does not specifically teach the tomato composition as including 5.5-20% dry matter as recited in claim 24, the tomato composition as sterilized or processed under sterile conditions as recited in claim 47, and the separation apparatus hole diameters as not greater than 0.1 mm as recited in claims 49, 50 and 51." Given such deficiencies, the rejection over **Bueno** should be found baseless as presented as not presenting a *prima facie* case of obviousness.

The Examiner further states at pages 9-10 of the Action:

"regarding the tomato composition as including 5.5-20% solids, **Bueno** teaches that the tomato composition has a solids content of about 28%. It was known in the art at the time the invention was made to adjust the water content of vegetable paste and juice products depending on the desired sugar content per

serving, solid content per serving (i.e., the amount of pulp) and water content per serving. It would have been obvious to one of ordinary skill in the art at the time the invention was made to increase the water content of the tomato composition in order to decrease the amount of sugar per serving of the tomato composition (i.e., in order to reduce the calorie content of the composition) and/or the amount of pulp per serving in the tomato composition (i.e., in order to form a composition with a more smooth texture) and/or to increase the water content of the tomato composition (i.e., in order to form a mixture which would better hydrate the consumer)."

Prior to addressing the merits of the rejection over **Bueno**, applicant believes that some background discussion is in order regarding applicable technical "tomato" definitions.

"Tomato juice" is defined by the Food, Drug and Cosmetics Act as being "the ununconcentrated liquid extracted from mature tomatoes . . . such liquid is strained free from skin, seeds and other coarse or hard substances, but carries finely divided insoluble solids from the flesh of the tomato". See the attached Exhibit 1 (Goose et al literature article at page 114).

"Tomato serum" is defined as tomato juice which consists of a dispersing medium (serum) and suspended particles . See **Tanglerpaibul** et al at page 318 (of record).

From the above discussion, it is obvious that during the first processing stages of tomato the seeds and skin are separated from the tomato juice, which is a suspension containing finely divided insoluble solids.

The above is important as the Examiner presumes that the cited **Bueno** reference teaches that water insoluble solids are divided from the tomato serum, whereas **Bueno** actually divides a slurry containing seeds and peels from the tomato juice which juice contains water insoluble solids. Indeed, the Examiner takes the position in the Office Action that "**Bueno** teaches . . . separation of tomato serum from water insoluble solids using a separation solid-liquid apparatus wherein the tomato juice is maintained under stirring (abstract)." This teaching is not confirmed by a reading of **Bueno**. Instead, **Bueno** teaches the separation of tomato juice from a slurry

containing seeds and peels using a separation solid-liquid apparatus wherein the heated tomatoes are maintained under stirring.

The Examiner further takes the position in the Action that “**Bueno** teaches that the insoluble material separated is macerated to particles with a diameter of less than 0.15 mm and then recombined with the tomato serum.” This alleged teaching is also not present in **Bueno**. The reference instead teaches that the separated slurry is macerated to obtain at least 90% of particles having a diameter lower than 0.8 mm, 70% of particles having a diameter lower than 0.5 mm, 50% of particles having a diameter lower than 0.3 mm, and 20% of particles having a diameter lower than 0.15 mm (page 5, lines 10-13), and then recombined with the tomato juice.

The claimed invention thus distinguishes over **Bueno** with respect to the claimed tomato composition, differences in the chemical composition, the content of insoluble solids, and the process used to produce such a composition.

**Bueno** prepares a tomato composition using a tomato slurry which is macerated to particles as discussed above, which is then recombined with tomato juice. At page 3 of **Bueno**, the tomato slurry is defined as follows: “tomato slurry designates a mixture of tomato pulp, skin, seeds and fibers originating from tomato cell walls and which are of sufficient big size to be rejected from standard tomato juice extractors”.

It is well known that seeds and peels are considered waste materials by the tomato industry. In fact, such seeds and peels have a different composition than those of insoluble solids present in tomato juice and used as animal feed. The Examiner’s attention is directed to the attached Exhibit 2 (Lazos), Exhibit 3 (Cantarelli) and Exhibit 4 (Tsatsaronis) in this regard.

It is further obvious that the tomato products prepared by **Bueno** have a chemical composition (and therefore nutritional and organoleptic properties) different from the tomato



compositions described in the instant application, which compositions are prepared using the insoluble solids present in tomato juice and then recombined with other tomato juice.

The solid/liquid separation methods described in the instant application also differ from those of **Bueno**. To demonstrate this fact it is noted that in the instant application the insoluble solids are separated, whereas in **Bueno** only the skin and seeds are separated, with the insoluble solids *remaining* in the liquid residue (the tomato juice).

The respective compositions also differ based on the content of insoluble solids. At page 9 of the Action, the Examiner states at lines 15-19 that “**Bueno** teaches that the composition includes about 24% water insoluble solids based on the total solids – Example 1, Table 3 (90.1% water soluble matter)/(90.1% water soluble matter + 28.98%/dry matter) = about 24% water insoluble solids based on the weight of the total solids”. The expression “water soluble matter” does not conform to the Table 3 used by **Bueno**. Nowhere in Table 3 is the expression “water soluble matter” used. Instead, in Table 3 of **Bueno** the expression used is “water soluble matter (% calcination)”. The two expressions “water soluble matter” and “water soluble matter (% calcination)” have totally different meanings.

The term “water soluble matter” indicates a matter soluble in water that consists only of inorganic compounds or only of organic compounds or both (organic and inorganic together). The last embodiment is the case for tomato products and generally of all vegetables. In tomato products there is a marked preponderance of organic compounds.

The expression “water soluble matter (% calcination)” indicates matter soluble in water that consists exclusively of inorganic compounds and is obtained with an initial operation of calcination. Exhibits 5 and 6 submitted herewith report the analytical schemes used in order to

obtain the content of water soluble matter (calcination) starting from fruit and vegetable juices (Exhibit 5) or canned vegetables (Exhibit 6).

Exhibit 5 contains at page 3 the definition of ash content of "The residue of a fruit or vegetable juice or related product obtained with organic constituents and water are completely removed by calcination expressed in g/l".

Therefore, it clearly results that (1) the initial process is a calcination that allows one to obtain the ash content, and (2) during calcination the organic constituents and the water are completely removed.

From Exhibit 6 applicant directs the Examiner's attention to paragraphs 32.027, 31.012, 31.013, and 31.015. At paragraphs 32.027, 31.012 and 31.013 a description is found of the methods used to determine Ash. At paragraph 31.015 is found the description of the method used to determine soluble and insoluble Ash.

The soluble Ash coincides with the water soluble matter (calcination). The percentage of soluble Ash present in Ash coincides with the water soluble matter (% calcination) referenced by **Bueno**.

In the case of **Bueno**, the Examiner is misled by the lack of indications regarding the analytical methods used.

The calculation method used by the Examiner that leads to a specific content of from 24% of water insoluble solids in dry matter is incorrect. The effective content of water insoluble solids is instead 3.38%.

At page 5 of the instant application (paragraph [0087]) the calculation method is specified which is used to determine water insoluble solids:

"The determination of water insoluble solids has been carried out by calculating the weight difference between the dry residue and that of water

soluble solids (Brix value) as reported in "Tomato production, Processing and Technology", 3<sup>rd</sup> edition, by W.A. Gould, CTI Publications, Inc., 1992, page 317 (see Exhibit 7).

Table No. 3 of **Bueno** indicates the necessary values for the calculation of water insoluble solids as Brix 28.0 and Dry matter (%DM) 28.98. Following the same procedures reported by the above Gould publication, the result obtained for **Bueno** is instead 3.38% of water insoluble solids in dry matter. The level of water insoluble solids taught by **Bueno** is thus actually far below the minimum amount of 18% required by claim 24.

The rejection over **Bueno** is accordingly without basis, and should be withdrawn.

### Conclusion

It is respectfully submitted that the Examiner has not met the tests set forth by the Courts to support a *prima facie* case of obviousness. It is the applicant's view that hindsight reconstruction is being used to allegedly assert obviousness against the claims in the present application. Having established unobviousness for claims 24 and 25, it is clear that the remaining claims should also be allowable.

Indeed, considering the **Glasser** and **Bueno** patents not only for what they teach, but also their deficiencies, it is submitted that the applicant has presented claims, which are not only novel but are also nonobvious with respect to the prior art.

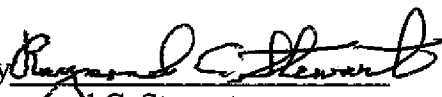
The foregoing amendments and remarks are fully responsive to the Office Action of May 17, 2007. Thus, favorable consideration and allowance of the claims are respectfully requested.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Raymond C. Stewart, Reg. No. 21,066 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Payment in the amount of \$230.00 is submitted herewith as payment for the requested two month extension of time.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Respectfully submitted,

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